

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PING-WEN ONG

Appeal No. 2004-1466
Application 09/342,408

ON BRIEF

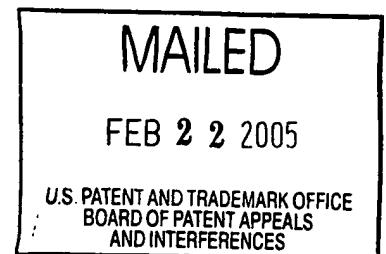
Before THOMAS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-25, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for providing an electronic document having multiple



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versions, each of said versions having a time-stamp. Requests for the electronic document can include a variable time-stamp so that a plurality of versions of the document corresponding to the variable time-stamp can be identified.

Representative claim 1 is reproduced as follows:

1. A method for providing an electronic document, said electronic document having multiple versions, each of said versions having a time-stamp, said method comprising the steps of:

receiving a request for said electronic document, said request including a variable time-stamp; and

identifying versions of said electronic document corresponding to said variable time-stamp.

The examiner relies on the following references:

George	5,832,478	Nov. 03, 1998
Sawashima et al. (Sawashima)	5,946,699	Aug. 31, 1999 (filed Aug. 04, 1997)
Kisor et al. (Kisor)	5,978,847	Nov. 02, 1999 (filed Dec. 26, 1996)
Tagawa	5,991,773	Nov. 23, 1999 (filed Apr. 29, 1997)
Allard et al. (Allard)	5,991,802	Nov. 23, 1999 (filed Nov. 27, 1996)

Kolb-Proust Archive, "Search the Kolb-Proust Archive Documents," <http://gateway.library.uiuc.edu/kolbp/Search1.html>, 1997, pages 1-16.

Compose Search, "How to Compose a Search," 1997, pages 1-2.

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The following rejections have been made by the examiner:

1. Claims 9, 11, 12, 21, 23 and 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

2. Claims 1-3, 5, 6, 13-15, 17, 18 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Tagawa.

3. Claims 4 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of Kisor.

4. Claims 4 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of Allard.

5. Claims 8, 9, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of Sawashima.

6. Claims 8, 9, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of Kolb.

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7. Claims 7, 10, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of George.

8. Claims 11 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of George and Kolb.

9. Claims 12 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tagawa in view of George, Kolb and Compose a Search.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of claims 8, 9, 20 and 21. We reach the opposite conclusion with respect to the examiner's rejection of all the other claims on appeal. Accordingly, we affirm-in-part. We also enter a new ground of rejection using our authority under 37 CFR § 41.50(b).

With respect to the rejection of claims 9, 11, 12, 21, 23 and 24 under the second paragraph of 35 U.S.C. § 112, appellant has indicated that he is not appealing the rejection, but instead, has filed a proposed amendment to the claims [supplemental brief, page 3]. The examiner has indicated that the amendment will be considered after this appeal is decided [answer, page 16]. Therefore, since the rejection under 35 U.S.C. § 112 has not been appealed by appellant, we sustain this rejection of claims 9, 11, 12, 21, 23 and 24 on a purely technical basis.

We now consider the rejection of claims 1-3, 5, 6, 13-15, 17, 18 and 25 under 35 U.S.C. § 102(e) as being anticipated by Tagawa. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well

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as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Tagawa [answer, pages 5-7]. With respect to independent claims 1, 13 and 25, appellant argues that Tagawa fails to disclose that the request for an electronic document includes a variable time-stamp as that term is defined in the specification [brief, pages 4-5]. The examiner responds that the timestamp in Tagawa is a variable time-stamp as claimed [answer, page 17]. Appellant responds that the timestamp taught by Tagawa is for a specific time rather than a variable time-stamp as claimed [reply brief, pages 2-3].

We will not sustain the examiner's anticipation rejection based on Tagawa. As noted by appellant, the specification discusses a time stamp, and then notes that "variable time stamps can be utilized in accordance with the present invention to indicate a number of different dates, such as a date range or a recurring period of time" [page 2, lines 26-27, emphasis added].

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Thus, a variable time-stamp results in requesting a number of different dates. We agree with appellant that the request in Tagawa includes a single fixed date as the time stamp. Although earlier or later versions of the accessed document can be retrieved using the history buttons in Tagawa, the request per se includes a fixed time stamp rather than a variable time-stamp as claimed. Thus, Tagawa does not disclose each and every feature of the claimed invention.

We now consider the various rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Appellant's only arguments with respect to the rejections under 35 U.S.C. § 103 are that none of the additionally applied references teach or suggest the variable time-stamp as required by the claims [brief, pages 5-7]. The examiner responds that Sawashima and Kolb teach searching using a variable date range and, thus, teach a variable time-stamp as claimed [answer, pages 17-18]. Appellant responds that none of the additionally cited references, including Sawashima and Tagawa, disclose or suggest the variable time-stamp as claimed [reply brief, pages 3-4].

As noted above, appellant does not argue the patentability of the individual claims rejected under 35 U.S.C. § 103 based on the limitations of those claims, but only argues that the secondary or tertiary references do not teach a variable time-stamp as claimed. We disagree with appellant's argument at least with respect to Sawashima and Kolb. With respect to Sawashima, it is stated that

As a method of designating the version, in addition to a method of clearly designating the version No., a method of designating a date or date range is available. In the latter method, the version management unit provides data corresponding to the designated date or the date range [column 13, lines 15-19].

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Thus, Sawashima clearly teaches that data can be accessed using a date range as a variable time-stamp. With respect to Kolb, a date range for searching for documents is clearly shown on the front page of the document. Thus, Kolb also clearly teaches that data can be accessed using a date range as a variable time-stamp. When the teachings of Tagawa and either Sawashima or Kolb are considered together, we are of the view that the artisan would have been motivated to modify the document access device of Tagawa to include a variable time-stamp as taught by Sawashima or Kolb. This modification would have allowed the artisan to access a plurality of document versions in Tagawa without having to use the forward and reverse history buttons. Therefore, we find that it would have been obvious to the artisan to replace the fixed timestamp of Tagawa with a variable time-stamp as taught by Sawashima and Kolb to obtain the advantages taught by Sawashima and Kolb.

Based on this finding, any claims that are rejected based on Tagawa and Sawashima or Tagawa and Kolb are obvious for the reasons just discussed. Since claims 8, 9, 20 and 21 are so rejected, we sustain the examiner's rejection of these claims.

In summary, we have sustained the examiner's rejection of claims 9, 11, 12, 21, 23 and 24 under 35 U.S.C. § 112. We have

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not sustained any of the examiner's rejections based on prior art except for the rejections of claims 8, 9, 20 and 21 based on Tagawa and Sawashima or Tagawa and Kolb. Therefore, the decision of the examiner rejecting claims 1-25 is affirmed-in-part.

We make the following new ground of rejection using our authority under 37 CFR § 41.50(b). We reject independent claims 1, 13 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the collective teachings of Tagawa and either Sawashima or Kolb. Since these claims are broader than claims 8, 9, 20 and 21 discussed above, the new rejection of these claims is based on the same rationale discussed above in sustaining the rejection of claims 8, 9, 20 and 21. We have only considered the independent claims for this new ground of rejection. We leave it to the examiner to determine the extent to which additional new rejections against the other claims on appeal may be appropriate.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13,

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2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

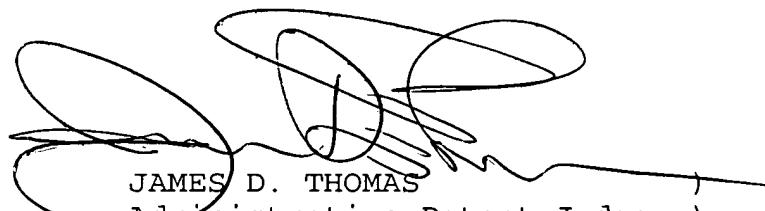
Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART
37 CFR § 41.50(b)

JAMES D. THOMAS)
Administrative Patent Judge)

JERRY SMITH)
JERRY SMITH)
Administrative Patent Judge)

HOWARD B. BLANKENSHIP)
HOWARD B. BLANKENSHIP)
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